

## **REMARKS**

### **Status of the claims**

Claims 13-41 are pending.

No amendments are made by this response.

### **Brief Summary of Embodiments of the Invention**

In one embodiment of the Applicant's invention, a gaming apparatus includes a random number generator; a skill game device that allows a game player to play a skill game, the skill game having a skill game outcome, the skill game outcome being shown to the game player, wherein the skill game outcome may be influenced by the player; a processor in communication with the random number generator, the processor configured to randomly determine a prize, the processor configured to calculate a multiplier, the multiplier being a quotient of the prize divided by the skill game outcome; and a display in communication with the processor and the skill game device, the display being configured to display the prize and the multiplier to the player.

In another embodiment of the Applicant's invention, a gaming method includes determining a prize; allowing a player to use skill to determine a skill game outcome while playing on a skill game device; dividing the prize by the skill game outcome to determine a multiplier; displaying the multiplier to the player on the skill game device; and awarding the prize to the player, wherein the prize appears to be the product of the skill game outcome and the multiplier.

### **Claim rejections – 35 USC §103**

Claims 13-27, 40 and 41 stand rejected under 35 USC §103(a) as being unpatentable over Bansemer (US 6,780,103). With respect, the Applicant disagrees.

The present invention is related to the general problem with gaming devices of how to engage a player to provide the player with a greater entertainment experience. One way to engage a player is to provide a gaming device where a player's skill rather than pure chance determines the game outcome. However, legislation in many jurisdictions mandates that the game outcome must be random and does not allow for the game outcome to be based in any way on a player's skill so that all players have an equal chance of winning.

The present invention thus relates to ways in which a game of skill, which engages a player, can be incorporated into a gaming device in which the outcome is determined randomly. As defined in present claim 13, the skill game outcome is incorporated into the random outcome by showing the player their achieved skill game outcome and by calculating a specific multiplier that is a quotient of the prize divided by the skill game outcome.

The Bansemer reference appears to also relate to gaming devices that incorporate skill games. However, Bansemer either teaches actual skill games, which have no randomly determined component (see Column 7, from line 62) OR Bansemer teaches pseudo-skill games in which the skill game outcome is NOT influenced by the player (see Column 10, from line 62). In other words, Bansemer teaches **only**:

1. a true skill game where the outcome of the game is determined by the skill of the user;  
and
2. a game that may appear to the player to be determined by skill, but in fact is not at all influenced by the player.

To modify the first game above to achieve the present invention would defeat the purpose of the game. Why would one use a randomly determined game outcome when it is the purpose

of the game to provide an outcome that is only determined by the skill of the player? Of course, some one of ordinary skill in the art would not make that modification.

With regard to the pseudo-skill game (number 2 above), to modify this game to achieve the present invention would also be contrary to the teaching of the reference. As acknowledged in the Office Action (see page 3, line 12) Bansemer teaches that the outcome of the pseudo-skill game is predetermined. For example, column 9, lines 2-3 of Bansemer actually teaches away from the present invention by stating that the outcomes of the skill games “are determined based on probabilities unrelated to the player’s decisions”. The shooting game example discussed in column 11 of Bansemer or the flash card game discussed in column 12 both rely on visual tricks to convince the player that their actions determine the skill game outcome. The flash card game, for example, requires the cards to flash too quickly for a player to judge whether their timing selections have been successful (see column 12, lines 35-38). Why would one provide an actual skill game component with a skill game outcome when the reference teaches that there is no skill game outcome? Someone of ordinary skill in the art would not think to go against the teachings of the references in such a way.

By contrast, the present invention has a true skill game where the skill game outcome is genuinely influenced by the player. The advantages of this system over Bansemer include that visual tricks are not required to make a player believe that their skill is affecting the skill game outcome. In an example of the present invention, a player could play the target shooting game of Bansemer and the game control could make it completely apparent that a target has been successfully shot due to a player’s skill and timing selection, e.g. by moving the targets slowly. This can create a more substantial emotive effect upon the player, enhancing player enjoyment and increasing player time. A further advantage is that a greater number of skill games can be

used, not just games that can incorporate the visual tricks required by Bansemer to deceive the player. In the presently claimed invention, any skill game outcome achieved by the player can be modified by the appropriate calculation of the multiplier to produce the required total prize outcome.

Bansemer does not teach that a true skill game outcome can be used in a gaming device having a random outcome, as defined in present claim 13. Specifically, Bansemer does not teach a gaming device as defined by claim 13 having a random number generator, a processor that randomly determines a prize and a skill game in which the skill game outcome may be influenced by the player. **For these reasons, the Applicants contend that claim 13 is patentable over the teachings of Bansemer.**

The Applicants have previously argued that Bansemer does not teach the specific multiplier claimed. In the Office Action, the Office acknowledges that Bansemer does not teach the specific multiplier but counter-argues that the multiplier is a mere obvious variation of a mathematical formula and refers to Bansemer column 13, lines 1-9 for support of this contention. Column 13, lines 1-9 as far as they relate to multipliers, state:

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event involving skill 58, which is a multiplier. The game multiplies the award 66 by a base game number, here the player's total bet, to arrive at a total win of credits. It should be appreciated that the game can award any form of prize such as a number of credits, a multiplier number that multiplies a number of gaming device credits or any other prize desired by the implementor, such as a number of picks from a group of credit producing selections. The awards can have any value desired by the implementor and can ultimately be exchanged for money.

Bansemer merely teaches multiplying a base game outcome by an awarded multiplier that has been randomly selected in order to calculate a total game outcome. That is, Bansemer teaches that the pseudo-skill game outcome IS the multiplier. This is in complete contrast to the present invention where the multiplier can only be calculated once the random game outcome and the skill game outcome have been determined. Present claim 13 defines a processor that is able to calculate a multiplier being the quotient of a prize divided by the skill game outcome. Bansemer does not teach calculating multipliers by any formula, let alone the presently claimed formula. Bansemer only teaches randomly determining a multiplier. **For these reasons, the Applicants contend that claim 13 is patentable over the teachings of Bansemer.**

The “mathematical formula” implied by the Office as being within the above quoted section of Bansemer is a straight multiplication of a base award number of credits by a multiplier. There is no other complexity or variation introduced to the mathematical formula. Moreover, the “mathematical formula” implied by the Office uses the multiplier but does not calculate the multiplier. The Office has provided no support as to how multipliers can be calculated. Importantly, the multiplier taught by Bansemer is randomly determined (see for example the flash card embodiment at column 12, specifically lines 35-39, which states the awarded multiplier is randomly determined). This contrasts greatly with the present invention in which the multiplier is calculated by a formula.

The claimed multiplier, being a quotient of the prize divided by the skill game outcome, may fall within the scope of all types of multipliers that may be awarded. However, that Bansemer discloses one type of multiplier is not sufficient to anticipate the present claim, otherwise there would never be a case where a claim of narrower scope than the prior art is allowed. To anticipate the claim, the prior art must teach the specific elements of the claim. In

the present circumstance, there is no teaching or suggestion in Bansemer of any method to calculate a multiplier. Bansemer only teaches that multipliers can be randomly determined.

The Applicants therefore argue that Bansemer does not teach or suggest the calculation of a multiplier that is the quotient of the prize divided by the skill game outcome. **For these reasons, the Applicants contend that claim 13 is patentable over the teachings of Bansemer.**

On a first glance, Bansemer may appear to relate to a concept similar to the present invention, namely to incorporate skill games into gaming devices having random outcomes. However, to cite Bansemer as a reference against the invention defined in present claim 13 is to ignore any specifically defined elements of claim 13 and does not consider the defined invention as a whole (see MPEP §2141.02). The Applicant contends that in citing Bansemer, the Office is impermissibly distilling the present invention down to the gist or thrust of the invention. The present invention may have some objectives that are similar to the objectives of Bansemer, but the present invention achieves those objectives in a way that is not obvious in view of Bansemere.

The invention is not just the creation of a perception that a player can influence a game outcome while maintaining a random game outcome, but specifically how that perception is created. This requires the elements, defined in the claims, of a genuine skill game in which the skill game outcome is truly determined by the player and the calculation of a multiplier which provides a link between the randomly determined outcome and the skill game outcome achieved by the player. Bansemer does disclose, teach or suggest these elements. The Office has not pointed to any portion of Bansemer as providing a motivation to modify Bansemer. Indeed, Bansemer appears to be a complete reference that would operate as intended to achieve its objectives. Someone of ordinary skill in the art would not be motivated to modify the reference

to achieve the present invention. **For these reasons, the Applicants contend that claim 13 is patentable over the teachings of Bansemer.**

In general, the prior art teaches only that multipliers can be randomly determined as an outcome of a game. There is no teaching that a multiplier can be calculated according to a specific formula. Calculation of multipliers according to a formula is only taught by the present application. To state that it would be a mere obvious variation to calculate the multipliers taught in Bansemer instead of randomly determining the multipliers is to apply impermissible hindsight and to import the novel features of the present invention into Bansemer. The Office offers no evidence to suggest, prior to the present invention, multipliers could be determined using a formula. As stated in MPEP §2142, in order to establish a *prima facie* case of obviousness, “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art”. Since the Office has not established that the prior art teaches calculation of multipliers by formulas, the Office has not established a *prima facie* case of obviousness against claim 13. **For these reasons, the Applicants contend that claim 13 is patentable over the teachings of Bansemer.**

For all of the reasons stated above, the Applicant contends that claim 13 and its dependent claims 14-33 are patentably distinguished over the cited prior art. Accordingly, the Applicants request that the 35 USC §103(a) rejection of claims 13-33 be withdrawn.

Claim 34 is an independent claim. Claim 34 defines a game playing method including a skill game outcome is determined by the skill of a player and that a multiplier is calculated by dividing a prize outcome by the skill game outcome. These elements are similar to the elements of claim 13 and therefore the reasons advanced above for the allowability of claim 13 apply equally with regard to claim 34 and its dependent claims. The Applicants therefore contend that

claims 34-39 are patentably distinguished over the cited prior art and request that the 35 USC §103(a) rejection of claims 34-39 be withdrawn.

Claim 40 is an independent claim. Claim 40 defines a gaming apparatus including means for allowing a player to play a skill game and to influence the skill game outcome and means for determining a multiplier that is the quotient of the prize divided by the skill game outcome.

These elements are similar to the elements of claim 13 and therefore the reasons advanced above for the allowability of claim 13 apply equally with regard to claim 40 and its dependent claim 41.

The Applicants therefore contend that claims 40-41 are patentably distinguished over the cited prior art and request that the 35 USC §103(a) rejection of claims 40-41 be withdrawn.

## **Conclusion**

For all of the above reasons, the Applicant submits that the present application is in condition for allowance. If the Examiner has any questions regarding the application or this amendment, the Examiner is encouraged to call the Applicant's attorney at (775) 826-6160.

Respectfully submitted,

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